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Supreme Court, U.S.
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No. 01-740

IN THE

Supreme Court of the United States

MYCOGEN PLANT SCIENCE, INC.
and AGRIGENETICS, INC.,

Petitioners,

v.

MONSANTO COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

Petitioners' corporate disclosure statements were set forth at page *ii* of the Petition for a Writ of Certiorari, and there are no amendments to those statements.

Petitioners Agrigenetics, Inc. and Mycogen Plant Science, Inc. (collectively, "Mycogen") submit this reply to Respondent Monsanto Company's ("Monsanto") Brief in Opposition to Mycogen's petition for a writ of *certiorari* (the "Petition") to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

REPLY TO MONSANTO'S REASONS FOR DENYING THE WRIT

1. Certiorari Should Be Granted For Question One Set Forth In Mycogen's Petition Because Any Modification Of *Festo* By This Court Combined With A Denial Of Mycogen's Petition For Question One Would Result In Unequal Treatment For Mycogen.

Question One in Mycogen's Petition invites this Court to employ the procedure of granting certiorari, vacating the judgment below and remanding the case (commonly referred to as "GVR") to the Federal Circuit to allow it to decide the issue of prosecution history estoppel in light of whatever decision this Court may render in *Festo Corporation v. Shotketsu Kinzoku Kogyo Kabushiki Co.*, No. 00-1543, argued January 8, 2002. *See* Petition at 17-18. This Court has GVR'd cases in response to developments in the law, including its own decisions. *See Lawrence v. Chater*, 516 U.S. 163, 166 (1996). This practice has a number of virtues, chief among them in this case that it "alleviates the '[p]otential for unequal treatment' that is inherent in [the Court's] inability to grant plenary review of all pending cases raising similar issues." 516 U.S. at 167. A GVR order is appropriate when:

> [I]ntervening developments, or recent developments that we have reason to believe the court below did not fully consider, reveal a reasonable probability

> that the decision below rests upon a premise that the lower court would reject if given the opportunity for further consideration, and where it appears that such a redetermination may determine the ultimate outcome of the litigation.

516 U.S. at 167.

Mycogen has property rights in claims 13 and 14 of U.S. Patent No. 5,380,831 ("the '831 patent"). The Federal Circuit woodenly applied the absolute bar to equivalents set forth in its decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000) (*en banc*), to claims 13 and 14, denying Mycogen any effective claim scope other than the literal nucleotide sequences recited therein. This decision, resting entirely on *Festo*, deprives Mycogen of its property. If this Court resolves its hearing of *Festo* with any rule other than a blanket affirmance of the "absolute bar," the *Festo* issue that is the subject of Mycogen's Petition would then rest entirely on a discarded premise. The proper course would be a remand to the Federal Circuit to allow that court to consider and analyze the parties' arguments free from the "absolute bar."

Monsanto, attempting to avoid a remand in which any decision by this Court in *Festo* could be addressed, ignores the fact that the Federal Circuit relied solely on *Festo* in affirming the district court, and re-argues its original position based on pre-*Festo* law. The Federal Circuit's use of *Festo* to avoid the arguments and analysis the parties presented, however, is what makes the GVR procedure wholly appropriate here. Plainly, the Federal Circuit's opinion does not reflect consideration of the parties' pre-*Festo* arguments concerning the doctrine of equivalents. That court dispensed with those arguments and instead relied on the *en banc Festo* decision — decided after briefing and oral argument in this case — to uphold the district court judgment on equivalents. *See Mycogen*, 234 F.3d at 1319-20 and 261 F.3d at 1349-50.

If this Court's disposition in *Festo* either restores the pre-*Festo* flexible bar regarding the doctrine of equivalents or announces a new rule that is different from both the pre-*Festo* flexible bar and the Federal Circuit's absolute bar, Mycogen is entitled to have the limits of its property rights in claims 13 and 14 of the '831 patent evaluated under the correct rule of law. Accordingly, this case meets the standards for GVR and this Court should use that procedure if its *Festo* decision in any way alters the absolute bar rule of the Federal Circuit's *en banc* opinion.

2. Monsanto's Prosecution History Estoppel Arguments Are Incorrect As A Matter Of Pre-*Festo* Law

Monsanto's prosecution history estoppel arguments are incorrect as a matter of pre-*Festo* law. Mycogen will not describe all of the deficiencies in Monsanto's arguments, as that is not appropriate in the context of a *certiorari* petition, and this Court should not in any case be addressing the merits of the prosecution history estoppel argument under pre-*Festo* authority now. That task, if made necessary by a reversal or modification of *Festo*, should be undertaken first by the Federal Circuit. However, Mycogen will respond to one of Monsanto's more egregious arguments, to demonstrate that a GVR is not futile but, instead, would return the case to the Federal Circuit for a redetermination that would directly impact Mycogen's claims of infringement of claims 13 and 14 of the '831 patent.

Contrary to Monsanto's unwarranted disparagement of Mycogen's argument as "linguistic nonsense," (Opposition at 16), it is actually Monsanto's position that is devoid of logic. Monsanto argues that, under pre-*Festo* law, Mycogen surrendered subject matter by canceling claims 2, 5 and 6, notwithstanding that claims 3 and 4 (which issued as claims 13 and 14) remained pending and depended from an independent claim that *was broader in scope* than any of

cancelled claims 2, 5 and 6. Because a prosecution history estoppel argument properly examines the scope of what subject matter was surrendered, Monsanto's position that Mycogen could somehow surrender narrow subject matter while retaining claims *broader in scope* than the purportedly surrendered subject matter is logically absurd. Whatever Mycogen may have surrendered is governed, at the outer boundaries, by the scope of the broad independent claims, not by the scope of cancelled intermediate claims that were narrower in scope than the independent claims that remained pending in the application.

Mycogen's later cancellation of these broader independent claims does not change this analysis, as Mycogen continued to pursue them in a continuation application, a course of action implicitly sanctioned by the Federal Circuit as a means for avoiding imposition of prosecution history estoppel under pre-*Festo* law. *Haynes Int'l., Inc. v. Jessop Steel Co.*, 8 F.3d 1573 (Fed. Cir. 1993), *amended by*, 15 F.3d 1076 (Fed. Cir. 1994). In *Haynes*, the patentee cancelled two broad claims and re-wrote dependent claim 5 as an independent claim when the Board of Patent Appeals and Interferences concluded that claim 5 was patentable, but claims 1 and 4 were not. 8 F.3d at 1577. In considering the application of prosecution history estoppel, the Federal Circuit concluded that prosecution history estoppel arose from the *combination* of cancellation of the broad claims *plus* the patentee's failure to refile a continuation application to pursue issuance of the broader claims. 8 F.3d at 1578. Indeed, the Federal Circuit observed "the cancellation of the claims did not establish that Cabot [the patentee] wanted to relinquish coverage of the subject matter encompassed by them and thus did not necessarily create an estoppel." *Id.*

In contrast to the patentee in *Haynes*, Mycogen pursued the broader claims in a continuation application, a fact that was recognized by the district court. The district court erred

when it concluded nevertheless that further pursuit of such broader claims was irrelevant. To the contrary, Mycogen followed the very path sanctioned by the Federal Circuit to avoid blanket application of the estoppel by permitting allowable claims to issue and pursuing broader claims in a continuation application. Thus, under the pre-*Festo* rules of prosecution history estoppel, the scope of claims 2, 5 and 6 should have no bearing on Mycogen's ability to assert infringement under the doctrine of equivalents.

3. The Court Should Grant Certiorari To Correct The Federal Circuit's Erroneous Interpretation Of 35 U.S.C. § 271(g)

Mycogen rests on its Petition as a sufficient argument of the reasons to grant certiorari on the third question presented. *See* Petition at 24-29.

CONCLUSION

Mycogen's petition for a writ of certiorari should be granted.

Respectfully submitted,

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